

REMARKS

Claims 1-8, 10-20, 22 and 23 are pending in the application.

The Examiner has rejected the claims as being obvious over Mozilla in view of Ogle, Maurille and DeSimone.

1. Analysis of the Prior Art Cited by the Examiner

a. Mozilla

This reference is a news item from the Internet allegedly appearing in April 20, 1999. The Mozilla article discusses a prospective Instant Messaging (IM) and chat project “with the stated goal of supporting a wide variety of chat protocols” (lines 1-2). Note in particular the statements (with the underlines added) that “ Mozilla ... is charged to develop the Communicator browser code’ (lines 7-10); “ ...why the company would risk undermining such a valuable franchise” (lines 20-23); “Mozilla will base its support on its Instant Messaging application programming interface (API)” (lines 25-27); “We would like to make Mozilla be able to do chatting and ‘instant messaging’ “ (lines 29-30); “We would like Mozilla to be able to usefully talk to all of these protocols, and hide most of the differences from the user” (lines 33-35).

When taken together, these statements all indicate nothing more than the launching of a project. There is nothing to indicate whether the project was ever finished or whether it was ever able to perform the desired functions.

b. Ogle (U.S. Patent No. 6,430,604)

According to its Abstract, this reference pertains to a

A method, system, and computer program product for enabling messaging systems to use alternative message delivery mechanisms. In existing instant messaging systems, messages cannot be delivered to an intended recipient unless the recipient is currently logged on to an instant

messaging system. According to the present invention, users may register one or more alternative message delivery mechanisms (such as pagers, cell phones, etc.) through which they are available as an alternative to an instant messaging system. Constraints may optionally be added to these registered alternatives, such as specifying a limitation on days of the week and/or hours of the day when a particular alternative may be used.

In other words, this patent pertains to a system that allows the sending of messages from a PC to other devices, such as cell phones, etc. Note that this is a way communication path and that the recipient is not able to respond with an instant message.

c. Maurille (U.S. Patent No. 6,484,196)

This reference pertains to a special system in which messages in various forms, including e-mail, IM, chat and BBS messages are collected, listed in a predetermined order and then sent out to various designated participants in the form of a web page. Importantly, the web page is in a standardized html protocol. The messages in the various forms are displayed on the web page but at no time is there actual, real time communication established between any two participants.

d. DeSimone (U.S. Patent No. 6,212,548)

This reference pertains to a system that provides asynchronous chat room. In such a system, a chat server receives messages from several participants having a predetermined format, posts the messages on a common board and allows the participants to see the board with the messages from all the participants. The participants do not exchange messages between each other and at no time is a connection established between them that can be used for an IM session.

An obviousness determination is based on three factual inquiries: the content of the prior art, the level of ordinary skill in the art and the differences between the prior art and the claims at issue. Once these factual determinations are made a determination of obviousness is reached based on whether the claimed subject matter would be obvious to a person skilled in the art in light of the prior art. Graham v. Deere 383 U.S. 1, 148 USPQ 459 (1966).

A conclusion of obviousness must be predicated on a combination of two or more references. However, in reaching this conclusion, the Examiner cannot just pick and chose only as much as will support a given position, because that would constitute impermissible hindsight. In re Clayton 205 USPQ 269 (PTO Bd App. 1979). Instead, the reference must be considered for all its teachings.

Moreover, a combination of references to obviate a claim is improper unless the prior art suggests the combination. More specifically, before the PTO can combine the disclosure of two or more references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found in the references themselves or in the knowledge generally available to the person skilled in the art. In re Jones, 21 USPQ2d 1941 (Fed Cir. 1992).

As indicated above, the references cited by the examiner are the Mozilla, Ogle, Maurille and DeSimone references. When taken as a whole, Mozilla discusses a prospective project for developing a universal IM system. However, Mozilla fails to disclose any elements for making such a system.

Ogle discloses a system in which messages are sent from one type of device to several other types of devices. At no time is there a communication

established between two users from different realms that allows the users to exchange instant messages.

Maurille and DeSimone both disclose systems in which messages from various users are collected, listed in a predetermined order and made available on a common file for reading by the users. Two important features of these systems is that the common file is provided in a standard format (such as html) to all the users, and the local IM protocols of each user is immaterial. Furthermore, there is no connection established between two users that can provide an instant messaging session.

2. Differences between the Prior Art and the Claims at Issue

Claim 1 lists the following elements:

an IM manager;

an IM server;

an IM database with a listing of users currently connected to the Internet.

Mozilla has none of these elements. The Examiner claims that Ogle discloses an IM manager as claimed. The Applicant disagrees. Ogle discloses a server capable of sending messages to other devices in different formats, none of which are IM protocols. Ogle does not establish a connection for an IM session. The Examiner takes the position that Ogle and Maurille both disclose an IM server as recited in the claim. The Applicant disagrees. In both Ogle and Maurille, one user sends a message to another user. The other user receives and reads the message if and when he gets to it, and not during an IM session. While it is true that Ogle does have a listing of when some users may be available to receive a message, this information is merely advisory

in nature and is not indicative of whether the other user is actually on line and ready to exchange IM messages. As stated above, Maurrille merely collects messages from various sources, posts them on a web page and sends the web page out to the users. At no time does the system receive an indication or care whether a user is on line and capable of exchanging IM messages, or not.

Claim 6 lists the following elements:

an IM component for each device providing IM service; and
an IM database storing a list of users registered to access instant messaging and currently active.

None of these elements are found in Mozilla or the other references as discussed above.

Claim 16 recites a method for establishing an instant messaging session between a first and a second user including the step of “determining a current IP address of the second user.” There is nothing in Mozilla describing how IM is to be implemented.

The Examiner admits that Mozilla does not disclose these features. It is respectfully submitted that these elements are missing from the other references as well.

Thus, when viewed as a whole, the references fail to disclose the claimed subject matter.

Two or more references can be said to obviate a claim, only if they can be combined to teach all the claimed elements. As discussed above, each of the pending

claims recites one or more elements which are not found in the two references cited by the Examiner. In fact the Examiner admitted that Mozilla does not disclose any of the claimed elements. His reliance on Vaudreuil is ineffective, since Vaudreuil teaches nothing about IM systems or its elements. Therefore it is submitted that, as a matter of law, the Examiner failed to make out a prima facie case of obviousness.

Furthermore, there is no suggestion for modifying the secondary references. Taken as a whole, the Mozilla reference at most teaches to a person skilled in the art about the problems associated with exchanging IM messages across realms. There is nothing in the reference that suggests how this may be accomplished. There is nothing in this reference which points a person skilled in the art to Vandreuil or any other reference which may be used to solve this problem. The fact that a special project was required to solve this problem indicates that the solution is not trivial. That is, clearly, the solution was not merely to take some off the shelf items and perform slight modifications thereon. Because the solution is not trivial, it may be implemented in many different ways. The subject application provides two ways of implementing universal IM. There may be other solutions as well.

When taken as a whole, the remaining references disclose systems in which messages are sent from one device to another. The second device is then used to read the messages at some future time. At no time is there an actual connection established between the users that allows the exchange of instantaneous messages. As discussed above, while IM takes place real time on line the messages exchanged in the Ogle, Maurille or DeSimone system take place in a time-independent manner. Therefore the very mode of operation of the secondary systems are different than an IM

system. Hence, a person skilled in the art would not combine the two references in the manner suggested by the Examiner since they operate in a different manner and there is nothing in either reference that would suggest the combination, as opposed to many other combinations. In other words, since the two systems operate in different manner, the Examiner must be able to show why a person skilled in the art faced with the need for universal IM would rely on the secondary references. This last point is especially important in view of the fact that the secondary references describe systems that are not capable of providing universal IM without major reconstruction.

The issue here is whether a skilled person familiar with the problem of exchanging IMs across different realms (a problem admittedly recognized by Mozilla) would consider secondary references in arriving at a solution. It is submitted that a person skilled in the art would recognize that the secondary systems are not time-sensitive while IM systems are real time and therefore it could not be used for performing IM messaging without some major modifications and experimentation. There is no reason to modify secondary systems to exchange of real time message. Therefore, without something more specific, there is nothing in the secondary references or anywhere else that would suggest that it would be desirable to modify the secondary systems.

Importantly, in an IM system, an exchange of IM messages can occur only if both participants are on line at the same time and a connection is established between them. One user cannot send an e-mail message to another user who is not on line. Therefore, as recited by the claims, in the present invention, a database is provided to list all the current users. This database can be stored in various locations,

such as the local SP or a special IM server. Before IM messaging is allowed, this listing is checked to insure that the respective user(s) are capable of receiving and transmitting messages. This aspect of the invention is completely absent in the secondary references.

A key characteristic of all these types of message exchanges addressed in the secondary references is that they are time independent in the sense that a first user can send a message in any desired media to the second user. The message is stored and made available to the second user as desired by the second user.

Therefore, at the time the message is sent out by the first user, it does not matter whether the second user is on line or not. Hence, contrary to the Examiner's assertions, the secondary references do not need and do not disclose a database of current users.

In Conclusion, the Examiner has rejected the claims as being obvious over Mozilla and several secondary references. The Mozilla reference is nothing more than a press announcement of a proposed design project for universal IM. As the Examiner admitted, there are no details of any kind of implementation. The only thing disclosed by this reference is that there may be a need for universal IM but not how to do it.

The remaining references disclose systems in which messages from one type of device may be sent to other devices of the same, or a different type. However, at no time do any of these references discuss how the respective devices or systems should be modified or even why such modifications should be performed to establish a connection for IM messaging. In fact, if anything, these secondary references teach away from the invention because they teach that if a device is not available for IM

session or is not presently connected, one can send to it an electronic message, such an e-mail or a web page with a listing of other messages.

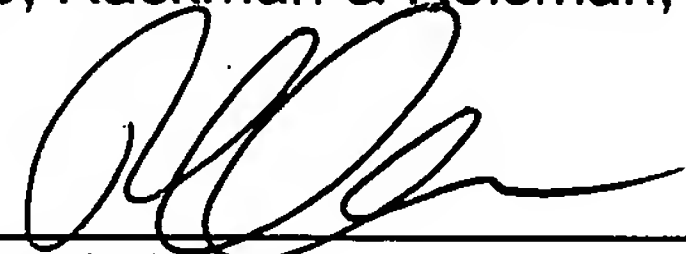
It is respectfully submitted that the Examiner has failed to show that (1) specific claimed elements are found in the prior art; (2) the prior art could be modified to obtain the claimed elements; and (3) there is a suggestion for the combination of references to a person skilled in the art. Hence, has failed to make out a prima facie case of obviousness.

It is believed that, in view of the above, the present case is now in condition for allowance. If any questions remain, the Examiner is invited to contact the undersigned applicant's attorney at (212) 684-3900.

Enclosed with this Response is a Petition For Extension of Time under 37 CFR 1.136 (a) accompanying by the appropriate fee in the amount of \$ 420.00 as set forth in 37 CFR 1.17(a)(2). The Commissioner is authorized to charge any additional fees associated with filing of this communication to the firm's Deposit Account No. 07-1730, Docket No. 4031-001.

Respectfully submitted
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